

## REMARKS

**[0003]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-36 are presently pending. Claims amended herein are: 1, 21, 23 and 30-36. Claims withdrawn or cancelled herein are: None. New claims added herein are: None.

### Statement of Substance of Interview

**[0004]** The Examiner graciously talked with me—the undersigned representative for the Applicant—on May 28, 2008. Applicant greatly appreciates the Examiner's willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

**[0005]** During the interview, I discussed how the claims differed from the cited references, namely Danker and Nelson. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

**[0006]** The Examiner tentatively concurs that proposed amendments to independent claims 1, 23 and 30 would overcome the rejection based on Danker and Nelson. However, the Examiner indicated that he would need to review the cited art more carefully and/or do another search, and requested that the proposed amendments be presented in writing.

**[0007]** Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited art of record for at least the reasons discussed during the interview.

**Formal Request for an Interview**

**[0008]** If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0009]** Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

**Claim Amendments**

**[0010]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 21, 23 and 30-36 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references.

**[0011]** Support for the amendments to claims 1 and 30-36 is found, at least, in Figure 2 and at pages 5-6 and 9 of the specification.

**[0012]** Support for the amendments to claim 21 is found, at least, in Figure 7.

**[0013]** Support for the amendments to claims 23 is found at least at paragraph [0026] of the specification, "[a]n exemplary CEE 206 typically resides on clients 202, 204, that is, on a message sender's computing device 202 and a message receiver's computing device 204."

### **Formal Matters**

**[0014]** This section addresses any formal matters (e.g., objections) raised by the Examiner.

#### **IDS**

**[0015]** The Examiner made some objections related to IDS. The objections are respectfully traversed.

**[0016]** The U.S. Patent publication number 2002178230 questioned by the Examiner should be 20020178230.

**[0017]** A copy of European Search Report for EP 04102579.2 requested by the Examiner is attached in this response.

**[0018]** The other references requested, WO2004004139, EP0665670, and WO2005017660, were sent to the Patent Office on May 13, 2008. Applicant respectfully requests that these references be considered.

**[0019]** All of the objections should now be addressed and overcome. Withdrawal of these objections is requested.

## Substantive Matters

### Claim Rejections under § 101

**[0020]** Claims 23-36 are rejected under 35 U.S.C. § 101. Applicant respectfully traverses this rejection. Applicant submits that the § 101 rejections of claims 23-36 are moot in view of the amendments presented herein.

**[0021]** Particularly, Applicant notes that independent claim 23 has been amended to clarify that the claim is directed to a “custom emoticon engine having at least one physical component in a computing device” belonging to a statutory class of a manufacture or an apparatus, depending upon particular implementations. Support for the amendments to claims 23 is found at least at paragraph [0026] of the specification, “[a]n exemplary CEE 206 typically resides on clients 202, 204, that is, on a message sender's computing device 202 and a message receiver's computing device 204.”

**[0022]** Also, independent claim 30 has been amended to clarify that the claim is directed to a “computer readable storage media” belonging to a statutory class of a manufacture or an apparatus, depending upon particular implementations. Similar amendments apply to claims 31-36. Applicant further asserts that these claims are allowable. Accordingly, Applicant asks the Examiner to withdraw these rejections.

**[0023]** If the Examiner maintains the rejection of these claims, then Applicant requests additional guidance as to what is necessary to overcome the rejection.

### **Claim Rejections under § 103**

**[0024]** The Examiner rejects claims 1-9, 11-16, 21, 23-26, and 28-36 under § 103. For the reasons set forth below, the Examiner has not made a *prima facie* case showing that the rejected claims are obvious.

**[0025]** Accordingly, Applicant respectfully requests that the § 103 rejections be withdrawn and the case be passed along to issuance.

**[0026]** The Examiner's rejections are based upon the following references in combination:

- **Danker:** *Danker, et al.*, US Patent Publication No. 2002/0184309 (published December 5, 2002); and
- **Nelson:** *Nelson, et al.*, US Patent Publication No. 2004/0018858 (published January 29, 2004).

### **Overview of the Application**

**[0027]** The Application describes a technology for creating and transferring custom emoticons, which can be represented by a character sequence in real-time communication.

## **Cited References**

**[0028]** The Examiner cites Danker as the primary reference in the obviousness-based rejections. The Examiner cites Nelson as a secondary reference in the obviousness-based rejections.

### **Danker**

**[0029]** Danker describes a technology for electronic messaging. When a user changes their capability to engage in an electronic messaging session, for instance when they go offline, a command may be sent to other users. This command may take the form of a character sequence not normally occurring in written language, which is interpreted by network devices and changes the display of the icon associated with a user who went offline.

### **Nelson**

**[0030]** Nelson describes a communication device with emoticon input logic associated with an input key to improve the ease-of-use of the apparatus for entering emoticons, e.g. into a text message, while the apparatus is operating e.g. in a text mode. Responsive to a selection of the associated input key, one or more emoticons are displayed for selection.

## **Obviousness Rejections**

### **Lack of Prima Facie Case of Obviousness (MPEP § 2142)**

**[0031]** Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

### **Based upon Danker and Nelson**

**[0032]** The Examiner rejects claims 1-9, 11-16, 21, 23-26 and 28-36 under 35 U.S.C. § 103(a) as being unpatentable over Danker in view of Nelson. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims.

### **Independent Claims**

#### *Independent Claim 1*

**[0033]** Claims 1 is amended to clarify claimed features. Applicant submits that the combination of Danker and Nelson does not render obvious at least the following features as recited in this claim (with emphasis added):

"transmitting a text message including the character sequence to a destination to allow for reconstruction of the pixels at the destination, wherein the emoticon is to be substituted for the character sequence within the text message."

**[0034]** Danker describes a technology for electronic messaging. When a user changes their capability to engage in an electronic messaging session, for instance when they go offline, a command may be sent to other users. This command may take the form of a character sequence not normally occurring in written language, which is interpreted by network devices and changes the display of the icon associated with a user who went offline. The icon is not substituted for the character sequence transmitted. Danker fails to disclose, as in claim 1, "transmitting a text message including the character sequence to a destination to allow for reconstruction of the pixels at the destination, wherein the emoticon is to be substituted for the character sequence within the text message."

**[0035]** Nelson does not remedy this deficiency either. Nelson describes a communication device with emoticon input logic associated with an input key to improve the ease-of-use of the apparatus for entering emoticons, e.g. into a text message, while the apparatus is operating e.g. in a text mode. Responsive to a selection of the associated input key, one or more emoticons are displayed for selection. Nelson also fails to disclose "transmitting a text message including the character sequence to a destination to allow for reconstruction of the pixels at the destination, wherein the emoticon is to be substituted for the character sequence within the text message."

**[0036]** As shown above, the combination of Danker and Nelson does not teach or render obvious all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Independent Claim 14*

[0037] Applicant submits that the combination of Danker and Nelson does not render obvious at least the following elements as recited in this claim (with emphasis added): **"replacing the character sequence in the communication with the pixel array."**

[0038] As discussed above, in Danker, the command transmitted changes the display of the icon associated with a user who went offline. The icon does not replace the character sequence transmitted. Danker fails to disclose, as in claim 14, **"replacing the character sequence in the communication with the pixel array."** Nelson also fails to disclose those features quoted above.

[0039] As shown above, the combination of Danker and Nelson does not teach or render obvious all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Independent Claim 21*

[0040] Applicant submits that the combination of Danker and Nelson does not render obvious at least the following elements as recited in this claim (with emphasis added):

**"a means for sending the graphics data of the emoticon in a second communication from the first communication; and**

**a means for replacing the character sequence in the real-time first communication with the graphics data from the second communication."**

As discussed above, in Danker, the command transmitted changes the display of the icon associated with a user who went offline. The icon does not replace the character sequence transmitted. Also, there does not exist a separate communication to send the icon. Therefore, Danker fails to disclose "a means for sending the graphics data of the emoticon **in a second communication** from the first communication; and a means for **replacing** the character sequence **in the real-time first communication** with the graphics data from the second communication." Similarly, Nelson also fails to disclose those features quoted above.

**[0041]** As shown above, the combination of Danker and Nelson does not teach or render obvious all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Independent Claim 23*

**[0042]** Applicant submits that the combination of Danker and Nelson does not render obvious at least the following elements as recited in this claim (with emphasis added):

"a transmitter to send the character sequence in a text message to a destination, wherein the pixels **replace** the character sequence within the text message at the destination."

**[0043]** As discussed above, in Danker, the command transmitted changes the display of the icon associated with a user who went offline. The icon does not replace the character sequence transmitted. Therefore, Danker fails to

disclose "a transmitter to send the character sequence in a text message to a destination, wherein the pixels replace the character sequence within the text message at the destination." Similarly, Nelson also fails to disclose those features quoted above.

**[0044]** As shown above, the combination of Danker and Nelson does not teach or render obvious all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Independent Claim 30*

**[0045]** Claims 30 is amended to clarify claimed features. Applicant submits that the combination of Danker and Nelson does not render obvious at least the following elements as recited in this claim (with emphasis added):

"creating an emoticon by selecting an image associated with the emoticon by a sender;

representing the image as pixels for the emoticon;

assigning a character sequence to the emoticon, wherein the character sequence is assignable by the sender; and

transmitting a text message along with the character sequence to a destination to allow for reconstruction of the emoticon at the destination, wherein the emoticon is to be substituted for the character sequence in the text message and both the text message and the emoticon are to be received in the same dialog."

**[0046]** As discussed above, in Danker, the command transmitted changes the display of the icon associated with a user who went offline. The icon is not substituted for the character sequence transmitted. **Furthermore**, in Danker, the emoticon is created by someone else, not by the sender and the sender has to follow an existing rule to designate the emoticon by a character sequence, which is different from the present application where the character sequence is assignable by the sender. Also, in Danker, only a character sequence command is received, while in the present application, both the text message and the emoticon can be received. Therefore, Danker fails to disclose those features quoted above. Similarly, Nelson also fails to disclose those features quoted above.

**[0047]** As shown above, the combination of Danker and Nelson does not teach or render obvious all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

#### **All the Other Dependent Claims**

**[0048]** These claims ultimately depend upon independent claims 1, 14, 21, 23 and 30. As discussed above, claims 1, 14, 21, 23 and 30 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

**[0049]** As to claim 6, Danker and Nelson fail to disclose those features as recited in this claim (with emphasis added): "transmitting data representing the

pixels **in a second communication**, wherein the data **reconstructs** the pixels **in place of** the character sequence in the real-time first communication.” In either Danker or Nelson, there does not exist a separate communication to send the icon.

**[0050]** As to claim 17, Danker and Nelson fail to disclose those elements as recited in this claim (with emphasis added): “the retrieving further includes mapping to a **local storage medium** to determine if the pixel array has been **previously stored** in the local storage medium.” In either Danker or Nelson, there does not exist a decision mechanism to determine if the icon has been previously stored.

**[0051]** As to claim 19, Danker and Nelson fail to disclose those elements as recited in this claim (with emphasis added): “if the pixel array is **not located in the local storage medium**, then attempting to establish a **direct link** with a sender of the communication to **retrieve** the pixel array from a storage medium associated with the sender.” Neither Danker nor Nelson, teach a decision mechanism to determine if the icon has been previously stored. Also, neither reference discloses any further steps if the icon has not been previously stored.

**[0052]** During the interview, the Examiner indicated that he relied upon Official Notice for rejections of claims 17 and 19. Applicant respectfully disagrees. The MPEP states that “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of **instant and unquestionable demonstration** as being well-known” MPEP 2144.03A (citing In re Ahlert, 424 F.2d 1088 (CCPA 1970)(emphasis added)). Accordingly, official

notice is improper in this case, and the Office must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

**[0053]** More specifically, the present application discloses a method to send custom emoticons, represented by pixels. Depending on the communication channels, transmission of pixels may or may not take much bandwidth. An ordinary person skilled in the art therefore may not check whether the pixels are stored in the local storage medium. Applicant respectfully traverses and requests that the Office provide a reference teaching on determining whether the pixels are stored in the local storage medium comprising a cache of temporary files. More specifically, Applicant seasonably challenges the apparent Official Notice of the Office and thereby demands for the Office to produce authority for this statement, as required by the MPEP §2144.03(C). Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 17-18 and 19-20.

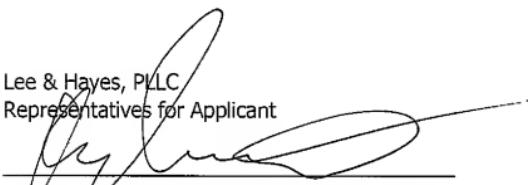
**[0054]** As to claim 33, Danker and Nelson fail to disclose those elements as recited in this claim (with emphasis added): "transmit data representing the emoticon **in a second communication**, wherein the data is used to **reconstruct** the emoticon **in place of** the character sequence in the real-time first communication." In either Danker or Nelson, there does not exist a separate communication to send the icon.

**Conclusion**

[0055] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me or my assistant at your convenience.

Respectfully Submitted,

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Representatives for Applicant

  
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